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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/412,261 10/05/99 BAUDET

P 98.601

EXAMINER

MM91/0330

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CRUZ, L
ART UNIT

PAPER NUMBER

2815
DATE MAILED:

03/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/412,261

Applicant(s)

BAUDET ET AL.

Examiner

Lourdes C. Cruz

Art Unit

2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

This Office Action is in response to an Application filed October 5, 1999.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: 4 (p. 5, line 9). Correction is required.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference signs not mentioned in the description: 4a and 4b. Correction is required.

Specification

The disclosure is objected to because of the following informalities: Reference to a claim (P. 3, line 5) in order to describe an invention is improper. The detailed description section of the disclosure has as a purpose to fully describe the invention in order to make it easy for one with skill in the art to understand it without having to make reference to the claims.

Furthermore, claim 1 is subject to change by submissions of further amendments. Accordingly the specification would become a variable subject to change upon re-drafting of claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, -second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "their" in line 3 of the claim. This phrase renders the claim indefinite for it lacks antecedent basis. Also referring to **Claim 1**, it is unclear as to what exactly the word "environment" is making reference to, rendering the claim indefinite.

Claim 2 recites the limitation "the surface of the substrate". **Claim 4** recites "the periphery". There is insufficient antecedent basis for these limitations in the claims.

Regarding claim 8, the phrase "it is" renders the claim indefinite since it is unclear as to what "it" is referring to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3-5, and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Derkits, Jr. et al. (US 5861665).

A semiconductor device comprising IC elements realized in a stack of layers on a substrate 15 and comprising means 33 for preventing pollution of the circuit elements and of the substrate by hydrogen (Col. 5, lines 55+) originating from their environment,

Art Unit: 2815

characterized in that said means are formed by a layer of a material which absorbs hydrogen, which forms a pattern which is integrated with the circuit elements and of which an external surface is exposed and in contact with said environment.

See that Derkits, Jr. et al. also teaches a device wherein the getter layer forms patterns arranged between the IC elements or along the periphery (**Claim 4**), and comprising titanium (**Claims 5 and 7**).

Regarding **Claim 8**, for the purpose of this Office Action, "it" is being examined as best understood by the examiner, which is that "it" refers to the getter. See that Derkits, Jr. teaches a getter 33 enclosed in housing 11.

With regard to claim 3, a "product by process" claim is directed to the product per se, no matter how actually made, In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Marosi et al, 218 USPQ 289; and particularly In re Thorpe, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above case law makes clear.

Art Unit: 2815

Claims **9 and 10** recite "an Intended Use limitation". See *In re Pearson* 181 USPQ 641 (CCPA) which makes clear that terms merely setting forth intended use for, or a property inherent in, an otherwise old composition do not differentiate claimed composition from those known to prior art. See also, *In re Swinehart* [169 USPQ 226] (CCPA 1971) which makes clear that mere recitation of a newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art.

Claims **1,4,5 and 6** are rejected under 35 U.S.C. 102(b) as being anticipated by Wolters et al. (EP 0513894).

Wolters teaches:

A semiconductor device comprising IC elements realized in a stack of layers on a substrate and comprising means for preventing pollution of the circuit elements and of the substrate by hydrogen originating from their environment, characterized in that said means are formed by a layer of a material which absorbs hydrogen (Col. 9, lines 50+) comprising palladium (**Claims 5 and 6**), which forms a pattern which is integrated with the circuit elements and of which an external surface is exposed and in contact with said environment.

See that Wolters teaches a getter arranged between the IC elements or along the periphery of the IC (**Claim 4**).

Art Unit: 2815

Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Evans Jr., Conte et al., Butt et al., Stupian et al., Wallace et al., and Kaloyeros et al., teach hydrogen getters comprising titanium or palladium.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lourdes C. Cruz whose telephone number is 707-306-5691. The examiner can normally be reached on M-F 8:00- 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lee can be reached on 703-308-1690. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Lourdes Cruz
March 12, 2001

Lourdes C. Cruz
Examiner
Art Unit 2815


EDDIE LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800